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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,156	12/12/2003	Bertrand Lion	LOREAL 3.0-002; OA02420/U	3506
530 7590 02/10/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER ROGERS, JAMES WILLIAM				
ART UNIT		PAPER NUMBER		
1618				
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02/10/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/735,156

**Applicant(s)**

LION, BERTRAND

**Examiner**

JAMES W. ROGERS

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-9,11,12,16,18-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 5-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,11,12,16,18-20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants amendments to the claims filed 12/22/2008 have been entered. Any rejection/objection from the previous office action filed 06/17/2008 not addressed below has been withdrawn.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This new rejection was necessitated by applicant's amendments to the claims. Specifically claim 1 now recites that the "dispersions are stable and do not phase separate" however it is not clear how a dispersion, which could read on an emulsion or undissolved particles in a liquid carrier as claimed could not contain more than one phase.

Claim 18 recites the limitation "'said proportion" in line 2, there is insufficient antecedent basis for this limitation in the claim.

#### ***Response to Arguments***

Applicant's arguments in regards to the 35 U.S.C. 102(b) rejection over Midha et al. filed 12/22/2008 have been fully considered but they are not persuasive. However upon further review by the examiner Midha is no longer anticipatory because applicant's claim 1 now incorporates the limitations of previous claim 17 that limits the amount of

macromer side chain to 2% to 16%. Midha does not teach an amount of macromer within this new range thus the reference is no longer anticipatory.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1,3-4,11-12,16,18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Midha et al. (WO 97/33556), for the reasons set forth in the previous office action filed 06/17/2008.

Applicants assert that Midha discloses graft copolymers in which the backbone and side chains phase separate into two distinct phases, immiscible interspersed microphases which is in contrast to their claimed invention where the polymer dispersions are stable and do not phase separate.

The relevance of this assertion is unclear. As noted above the limitation that the dispersion does not phase separate is unclear. However applicants invention as described within their own specification at [0039] and [0110] of the US publication US 20040156812 A1 of their application states that the acrylic backbone is insoluble in the liquid medium and the macromolecule side chains are soluble in the medium. Thus it would appear that applicants claimed graft copolymer particles also contains two phases in that the backbone is insoluble while the graft is soluble in the liquid medium just as in Midha. This is hardly surprising since Midha is obviously within applicants claimed scope, therefore the graft copolymers would have the same properties because it is obvious that the same compound will have the same properties. Furthermore the

examiner notes that Midha only refers to phase separation when the copolymer is dried. See abstract.

Claims 1,3-4,11-12,16,18-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over De La Poterie et al. (US 6,254,877 B1, '877 from hereon) in view of Midha et al. (WO 97/33556).

Applicants assert that one of ordinary skill in the art would not be motivated to combine '877 with Midha because '877 does not indicate that stable dispersions could be formed without the addition of stabilizing polymers and Midha specifically teaches polymer solutions free of dispersed particles. Thus applicants surmise that one skilled in the art would not have been motivated to add the graft copolymers of Midha without the addition of a stabilizing polymer.

The relevance of these assertions is unclear. Firstly motivation to combine is not the only consideration when determining obviousness, see KSR International Co. v. Teleflex Inc. (KSR), 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). Clearly one of ordinary skill in the art would have a reasonable expectation of success in substituting the graft copolymer of '877 with the graft copolymer of Midha since both the graft copolymers are very similar in structure and they are both useful in the same field of endeavor, cosmetic formulations. Secondly Midha clearly states that the personal care compositions can be in the form of dispersed particles of a copolymer and hydrophobic volatile solvent contained within a carrier. See pag 17 lin 31-35. Thirdly even if applicants are correct, something the examiner does not admit on the record, that if one of ordinary skill in the art combined '877 with Midha they would use a polymer stabilizer, such a stabilizer is

not precluded by the claimed invention because the transitional term "comprising", which is synonymous with "including", "containing", or "characterized by", is inclusive or open ended and does not exclude additional elements or method steps recited in the prior art. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

Applicants lastly assert that even though the comparative examples provided in applicant's declaration are different than Midha they are fully consistent with the finding reported in Midha. Applicants go on to state that Midha does not teach the importance of any claimed range and certainly does not teach the criticality of the claimed range between 2 and 16% of the polymer is side chain graft.

As noted previously by the examiner the comparative examples in the declaration all use side chains in excess of 20% by weight of the total polymer weight, but Midha clearly describes the use of graft copolymer with side chains in amounts of 20% by weight of the total polymer as in the examples and does disclose that amounts less than 20% can be used by the breadth of the ranges cited within. Thus applicant's comparative examples are not within the full scope of the types of graft copolymers encompassed by the teachings of Midha. Regarding the criticality of the claimed range, it is noted by the examiner that applicants so called unexpected results could be achieved with amounts of 20% side chain which is taught by Midha. While the reason to select the amount of side chain in Midha may differ than applicants reasoning presented within their specification it does not change the fact that an amount of side chain could be selected within applicants claimed range.

***Conclusion***

No claims are allowed at this time.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status

information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618